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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/999,730	12/24/1997	ROBERT H. STAAT	7311-24RE	4290

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2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103-7013

[REDACTED] EXAMINER

MORANO IV, SAMUEL J

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

3617

DATE MAILED: 03/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	08/999,730	STAAT, ROBERT H.	
	<b>Examiner</b>	<b>Art Unit</b>	
	S. Joseph Morano	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 October 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 2-9,17 and 21-34 is/are allowed.
- 6) Claim(s) 10,12-20 and 35 is/are rejected.
- 7) Claim(s) 36 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Pri rity under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 3617

**DETAILED ACTION**

1. Claims 35-36 are objected to because of the following informalities: On line 3 of both claims, -the- should be inserted before "coupler pocket". Appropriate correction is required.

As this is only a minor typographical change, a new supplemental declaration would not be required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On line 2 of the claim, "a spring" is confusing as it is unclear how this is related to the "leaf" spring and "cantilever" spring previously recited. In reviewing the claims in light of the specification and remarks, it is believed that this is a double recitation of the "leaf spring" of claim 9. Changing the dependency of this claim from claim 9 to claim 10 (which it is believed was applicant's original intention from applicant's remarks) should correct this problem.

***Reissue Applications***

4. Claims 10, 12-16 and 18-20 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, the claims improperly remove limitations that the prosecution history of the parent application indicates were essential to the allowance of the application. The reasons for allowance in the original applicant specifically state that the allowance of the application was because of "***the combination of all of the features claimed in claim 7*** (patent claim 1), in particular with the use of two stops on the coupling head for limiting pivotal movement of the coupler knuckle against the spring" (emphasis added). Because the application was allowed based on these limitations, and because applicant did not comment or request clarification from the

Art Unit: 3617

examiner with respect to these reasons for allowance set forth by the examiner, applicant acquiesced and effectively surrendered broader coverage outside of the scope of the combination of elements in originally allowed claim 7. Even though the claims were narrowed in another aspect, applicant still surrendered the right to broaden the claims beyond what the prosecution history indicated as being essential to patentability. The specific elements of the allowed combination that are missing are:

In claims 10, 12-15, the limitations of *a leaf spring being formed as a integral part of the first end of the drawbar and extending from the first end of the drawbar* is missing.

In claims 16, 18-20, the limitations of *a leaf spring being formed as a integral part of the first end of the drawbar and extending from the first end of the drawbar* is missing.

***Allowable Subject Matter***

5. Claim 35 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

6. Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 2-9, 11, 17 and 21-34 are allowed.

***Response Arguments***

8. Applicant's arguments filed October 28, 2002 have been fully considered but they are not persuasive.

Applicant's arguments are essentially to the same central issue as those that are already on the record, and the examiner's position relative to the issue of recapture has been exhaustively set forth in the record and has not changed. For brevity, the examiner position will not be repeated yet again, and applicant is referred to the examiner's previous responses as well as the discussion that took place in the Interview (summary attached to paper #32). The central issue of contention remains whether applicant can eliminate features from a patented claim that were indicated as necessary for allowance in the prosecution record of the parent application via the examiner's reasons for allowance. The examiner's position remains, and will remain, that because explicit reasons for allowance indicated that the combination of all of the features of patent claim 1 were required for allowance, the elimination of the leaf spring from that combination in this reissue application constitutes recapture because an element of the referred to combination is now missing.

As far as it being inequitable to reissue applicants when some cases have reasons for allowance and some don't, this is simply not the case. Recapture is the same for all cases whether they have reasons for allowance in the original patent or not; namely, applicant can not eliminate or take back limitations that were necessary for the allowance of the original patent claims. The fact that some prosecution histories require a reason for allowance to clarify exactly why the claims are patentable and some don't because the record is already clear, doesn't change the

Art Unit: 3617

central fact that in the claims at issue, applicant is attempting to remove limitations that the prosecution history of the original patent deemed necessary for allowance.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication should be directed to S. Joseph Morano at telephone number (703) 308-0230. Supervisory Patent Examiner Morano can normally be reached Monday through Thursday, 7:30am-5:00pm.

Sjm  
March 5, 2003



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